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Filed: May 29, 2001
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REMARKS

Claims 1-21 and 23-87 are pending in the application. The Examiner has rejected Claims 1-21 and 23-85 and 87 under 35 U.S.C. §112, second paragraph and claims 1-21 and 23-87 under 35 U.S.C. §103(a).

The rejection under 35 USC 112, second paragraph:

In the Office action of July 17, 2003 (OA) at page 12, the examiner has rejected claims 1-21, 23-85, and 87 under 35 U.S.C. §112, second paragraph urging that the term "smudge resistant", as used in claims 1-21, 23-85, and 87, is a relative term which is not defined by the claims or specification which would provide a standard for ascertaining the requisite degree. Thus, the Examiner concludes that one of ordinary skill in the art would not be reasonably apprised of the scope of the invention and thus the metes and bounds of what a "smudge resistant" composition are not clearly defined.

Applicants respectfully disagree. In the present claims, one of skill in this art would readily recognize what was intended by the language "smudge resistant" and would also appreciate the scope of the present claims. Further, it should be noted that the term "smudge resistant" is merely a characteristic of the claimed composition, which is attributable to the presence of the defined and required ingredients. For this reason, Applicants have cancelled the term "smudge resistant" from the claims, making the examiner's rejection on this ground moot.

The Rejection Under 35 USC 103

Prima Facie Case of Obviousness:

The applicants acknowledge, with appreciation, the withdrawal of the rejections of the claims under 35 U.S.C. §103(a) as unpatentable over McDermott ('336 B1), alone,

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as well as the rejection of the claims under 35 U.S.C. §103(a) as unpatentable over the combination of Shaw (WO 00/47168) in view of McDermott ('336 B1). The Examiner has maintained the rejection of claim 1-21 and 23-87 as unpatentable over Shaw ('168) and McDermott ('336 B1) in further view of Calello ('275).

Starting at page 9 of the Office Action, the Examiner has explained the rejection of claims 1-21 and 23-87 as unpatentable over Shaw ('168) and McDermott ('336 B1) in further of Calello ('275). The Examiner notes that Shaw:

Teaches long wearing cosmetic compositions for topical application to the skin that do not run or settle in the lines and creases of the skin. The Shaw reference teaches that the cosmetic compositions are particularly useful as eye liners, or other eye skin products. The Shaw reference teaches combining a acrylic acid or methacrylic acid derived polymer or copolymer and water soluble organic pigments to unexpectedly create a water resistant, long lasting film forming composition which can be applied to the skin. The Shaw reference teaches the specific organic pigments as claimed instantly and describes how it may be desirable to include small amounts of additional pigments such as inorganic pigments or combinations of organic and inorganic pigments. Therefore the Shaw reference teaches compositions which may or may not contain inorganic pigments as color imparting ingredients in their invention. Furthermore, the Example of a Longwearing Cosmetic Composition on page 6 does not contain inorganic pigments. Moreover, the reference does not teach waxes or organic gelling agents in the composition, therefore, meeting the negative limitations of claims 86-87. Shah teaches that the compositions of the invention include any aqueous base that is miscible in water and can include glycerin and hydroalcohols, such as ethanol, propanol, and glycols, thus meeting the plasticizer limitation of instant claims 25, 42, 44, 61, and 78 as well as the volatile components of instant claims 16-17, 36-37, 53-54, 71-72, and 84-85.

The Examiner acknowledges in the paragraph bridging pages 9-10, that Shaw ('168) does not teach (1) the specific water and oil emulsions as claimed instantly in claims 1-21 and 23-87, (2) the copolymer of instant claims 18-20, 38-40, 55-57, and 73-75, (3) the surface coating pigments as claimed in claims 33 and 50 and (4) the pigments comprised in specific phases as required by claims 3-4 and 30-85.

The Examiner explains that McDermott (OA - pages 10-11):

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teaches cosmetic make-up compositions, particularly eye make-up compositions, such as mascaras, in the form of aqueous emulsions. The emulsions are taught to comprising insoluble polymeric materials in an aqueous emulsion or latex and a lipophilic oil. The emulsions are then used to produce mascaras with improved wear and water resistance and are removable with soap and water. See: col. 1, lines 4-68 and abstract.

McDermott describes how polymeric emulsions containing plasticizers and solvents are well known in the art and that these compositions contain thickeners including water-soluble and water-swellaable polymers typically used in the art. See: col. 1, lines 26-40.

The McDermott reference describes how the compositions of their invention can be fabricated into a multitude of forms such as water-in-oil and oil-in water-emulsions to make creams and pastes. Thus, meeting the limitations of instant claims 1-2, 30, 48, 66, 81, and 86. The McDermott reference teaches that the proportions of pigments used depends on the color and intensity of the color desired and that the pigments are selected from inorganic pigments. Organic lake pigments, pearlescent pigments, and mixtures thereof. McDermott describes how the pigments may be surface-treated and teaches the specific inorganic and organic pigments of instant claims 5-8, 13, 31-33, 49-50, 67-68, and 82-83. See: col. 6, lines 1-45.

The McDermott reference teaches that optional ingredients such as silica, mica, talc, polymethacrylate, polyethylene, and thickeners such as water dispersible clays, which meet the specific limitations of instant claims 26-29, 45-47, 62-65, and 79-80. See: col. 6, line 45- col. 7, line 10. McDermott exemplifies as an object of the invention to provide a mascara composition which comprises an alkyl or alkoxy-dimethicone copolyol as well as the insoluble polymeric material in an aqueous medium. See: col. 2, line 1- col. 5, line 4.

McDermott teaches the use of polar oils and volatile oils, which meet the volatile components of instant claims 15-17, 36-37, 53-54, 71-72, and 84-85.

The Examiner acknowledges that McDermott "lacks the teaching of the phases in which the emulsions contain the pigments and the pigment colors of the instant claims 9-12, 14, 30, 48, 66, and 81." (OA, page 11).

The Examiner notes that "the combined references . . . teach an emulsified organic pigmented composition, which may further contain inorganic pigments, the references lack the specific copolymers of instant claims 18-20, 38-40, 55-57, and 73-75."

The Examiner relies on Calello et al. as teaching (OA, page 11);
glossy transfer resistant cosmetic compositions which can be incorporated into water and oil emulsions comprising a polymer, a volatile solvent, a nonvolatile oil, a dry particulate

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matter, and water. The tertiary reference teaches the specific silicone acrylate copolymers of instant claims 20, 40, 57, and 75 as being the most preferred polymers. The reference teaches that compositions comprising the polymer are long lasting, have a high gloss and shine and do not easily transfer to clothing or utensils. See col. 1, lines 45-68; col. 4, 22-26; col. 6, lines 52- col. 7, line 7; col. 8, lines 29-45; and abstract.

The Examiner concludes that (OA, page 12):

[I]t would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the . . . long wearing organic pigmented composition of Shaw by forming water and oil emulsion as taught by McDermott and adding the specific silicone acrylate copolymer of Calello et al. because of the reasonable expectation of obtaining an emulsified organic pigment containing composition that can have surface coated pigments, which could be added to any desired phase and could contain pigments of any desired color, with an improved long lasting adherence to the skin and having a high gloss and shine.

The applicants respectfully disagree with the Examiner's conclusion of the obviousness of the invention of claims 1-21 and 23-87.

Claim 1, as currently amended, is directed to a cosmetic composition which is in the form of a water and oil emulsion which is comprised of a water phase, an oil phase, at least one film forming polymer selected from the defined group of a copolymer of silicone and ethylenically unsaturated monomers, a polymer comprised of polymerized ethylenically unsaturated monomers, a silicone polymer and mixtures of these three types of polymers, and at least one organic pigment which is present in an amount of at least about 0.1-95% by weight of the composition and must be the main color component of the composition. The claim also provides that there is no inorganic pigment present and that the composition has a viscosity of about 1,000 to 500,000 centipoises at 25° C. The claim further provides that water is present in an amount of about 0.1-95% and that the oil is present in an amount of 0.1-99.9%. Claim 30 claims a similar cosmetic composition but provides that both an organic pigment and an inorganic pigment are

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dispersed in the oil phase of the cosmetic composition. Claim 48, also, claims a similar cosmetic composition compared to claims 1 and 30, but further stipulates that the organic pigment is solubilized in the water phase while at least one inorganic pigment is dispersed in the oil phase. Claim 66 is directed to a similar cosmetic composition but stipulates that the at least one organic pigment is dispersed in the oil phase, while at least one inorganic pigment is solubilized in the water phase. Claim 81 is directed to a cosmetic composition of the type claimed in claims 1, 30, 48, and 66, but stipulates that both the organic pigment(s) and inorganic pigment(s) are solubilized in the water phase. Claim 86 is directed to similar compositions wherein said compositions do not contain any synthetic or natural waxes. All of the independent claims require that the at least one organic pigment is present in an amount of about 0.1-95% by the weight of the composition and that, where the inorganic pigment is present, it is present in an amount of 0.001-15% by weight of the composition, but in all cases the organic pigment forms the main color component of the composition.

Initially, applicants would note that none of the references relied upon in rejecting the pending claims in this application disclose a cosmetic composition which includes the ingredients required by the presently amended claims where the composition has a viscosity of about 1,000 to 500,000 centipoises at 25° C. and where the organic pigment is the main color component of the composition and is present in an amount of 0.1-95% as now required by the claims. Further, as the Examiner has acknowledged Shaw does not describe or suggest an oil and water emulsion, the copolymer of instant claims 18-20, 38-40, 55-57, and 73-75, (3) the surface coating pigments as claimed in claims 33 and 50 and (4) the pigments comprised in specific phases as required by claims 3-4 and 30-85.

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McDermott discloses oil and water emulsions which include polymer film forming polymers of the type required by the present claims, but fails to specify that the organic pigment is present in an amount corresponding to the presently amended claim limitations and where the organic pigment is the main color component of the composition.

While McDermott may suggest that the pigments, in general, "are present in proportions depending on the color and the intensity of the color which is it intended to produce," (column 6, lines 6-8) this general teaching would not have suggested or directed one of ordinary skill to the particular situation where the organic pigment is the main color component of the composition.

Similarly, McDermott fails to address the limitation of claims 30, 48, 66, 81, and the claims which depend thereon, where the claim limitations require the organic pigment and the inorganic pigment, if present, to either be solubilized in or dispersed in a particular phase of the of the composition.

The reliance on Calello does not provide that which is acknowledged to be missing from both Shaw and McDermott. As noted above, Calello is relied upon merely to establish that the specific silicone acrylate copolymers of instant claims 20, 40, 57, and 75 have been used in oil and water cosmetic compositions. However, this reference fails to address or provide that which is specifically missing from both Shaw and McDermott, i.e. the use of the organic pigment in an amount of 0.1-95% where the organic pigment is the main color component of the composition, the specific claim designated viscosity of the claimed composition or those cosmetic compositions of 30, 48, 66, 81, and the claims which depend thereon which specifically require that the organic pigment and the

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inorganic pigment, if present, either be solubilized or dispersed in specific phases of the oil and water emulsion.

It is not applicants intent to suggest that the ingredients required in the presently claimed compositions are new to the field of cosmetic compositions. It is applicants' position that the specific combination of those ingredients required by the present claims is both novel and would not have been obvious to those of ordinary skill at the time of the invention by applicants. The Examiner has pointed to each of the references in turn as having certain ingredients or characteristics required by the present claims. However, no reference discloses compositions which include all of the required ingredients and particularly none of the references suggest or describe these ingredients as being used in the amounts or proportions required by the presently amended claims. Further, while McDermott and Calello may describe oil and water emulsions, neither specifies or explains how the specific film forming polymers required for the claimed compositions are combined with organic pigments in order to provide a cosmetic composition having a viscosity of 1,000 to 500,000 centipoises at 25° C. as required by the pending claims.

A conclusion of obviousness premised on a combination of references must identify a reason, suggestion, or motivation which would have led an inventor to combine those references. Pro-Mold & Tool Co. v. Great Lakes Plastics, Inc., 75 F.3d 1568, 1573, 37 U.S.P.Q. 2d 1626, 1629, (Fed. Cir. 1996)

It is insufficient that the prior art discloses the components of the claimed invention, either separately or in other combinations; there must be some teaching, suggestion, or incentive to make the combination made by appellants. Interconnect Planning Corp. v. Feil, 774 F.2d 1132, 1143, 227 U.S.P.Q. 543, 551 (Fed. Cir. 1985)

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(insufficient to select from the prior art the separate components of the inventor's combination, using the blueprint supplied by the inventor). Here there is no evidence or teaching which would have reasonably suggested or directed one of ordinary skill to combine the teachings of these diverse references in a manner which would reasonable lead to or result in the specific combination of ingredients in the specific form and amounts required by the pending claims. Absent some teaching of this nature demonstrated to be present in the prior art, the combination of references, presently relied on by the Examiner, fails to provide that evidence which would make the claimed subject matter obvious within the meaning of 35 U.S.C. §103.

As set forth in In re Kotzab, 217 F.3d 1365, 1369-70, 55 U.S.P.Q. 2d 1313, 1316

(Fed. Cir. 2000):

A critical step in analyzing the patentability of claims pursuant to section 103(a) is casting the mind back to the time of the invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field. . . Close adherence to this methodology is especially important in cases where the very ease with which the invention can be understood may prompt one to fall victim to the insidious effect of a hindsight syndrome wherein that which only the invention taught is used against its teacher. . .

Most if not all inventions arise from a combination of old elements. . . . Thus, every element of a claimed invention may often be found in the prior art. . . . However, identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. . . . Rather, to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the appellant. [citations omitted]

In other words, in the present application, the prior art relied on by the Examiner can be reasonably read only to demonstrate that most, if not all, of the ingredients of the presently claimed cosmetic composition are old for use in cosmetic composition.

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However, the references, whether viewed individually or taken in combination, do not provide any suggestion or direction which can be said to direct one of ordinary skill in this art to combine these ingredients in a manner to arrive at the specific claimed composition of the pending claims. As stated in Echolochem, Inc. v. Southern California Edison, 227 F.3d 1361, 1375, 56 U.S.P.Q. 2d 1065, 1075-76 (Fed. Cir. 2000) "There still must be evidence that a skilled artisan, . . . with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed." Here, there is no such evidence. Thus, this rejection reasonably appears to be based on the use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.

In rebuttal to the arguments previously submitted by applicants, regarding whether there was adequate suggestion or direction provided by the references relied on, the Examiner states (OA, pages 6-7):

Shah teaches long wearing cosmetic compositions for topical application to the skin that do not run or settle in the lines and creases of the skin. The reference teaches that the cosmetic compositions are particularly useful as eyeliners, or other eye and skin products. The reference teaches combining an acrylic acid or methacrylic acid derived polymer or copolymer and water soluble organic pigments to unexpectedly create a water resistant, long lasting film forming composition which can be applied to the skin. The primary reference teaches the specific organic pigments as claimed instantly and describes how it may be desirable to include small amounts of additional pigments such as inorganic pigments or combinations of organic and inorganic pigments. Therefore the reference teaches compositions which may or may not contain inorganic pigments as color imparting ingredients in their invention.

Applicants would not necessarily disagree with this characterization of Shah. However, it remains that Shah does not suggest or describe compositions where the organic pigment is the main color component, that the organic pigment is present in the amount

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required by the claims, that the composition have a viscosity of 1,000 to 500,000 centipoises at 25° C.

Similarly, the Examiner notes that McDermott "suggests that the skilled artisan can easily and readily choose any desirable pigments, including organic pigments with or without inorganic pigments, based on the color desired." (OA, page 7). Also, the Examiner urges that Calello "teaches glossy transfer resistant cosmetic compositions which can be incorporated into water and oil emulsions comprising a polymer, a volatile solvent, a nonvolatile oil, a dry particulate matter, and water. The reference teaches that the compositions comprising the polymer are long lasting, have a high gloss and shine and do not easily transfer to clothing or utensils." (OA, page 7). However, even if this reading of these two references are accepted, it remains that neither reference directs you to the particular compositions of the presently claimed invention. As the applicants understand the issue, the question is not whether the references are trying to obtain the results described in applicants' disclosure or whether the products of the reference could be modified to arrive at the claimed invention. The fact that something could be done is not the standard of obviousness under 35 U.S.C. §103. In re Gordon, 733 F.2d 900, 902, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984). The question is whether there is information available in the prior art references which would have reasonably suggested, directed or led one of ordinary skill in this art to the specific compositions presently claimed. Applicants' reading of these three references indicates that no such teaching is present. Thus, the only information available which would have led one of ordinary skill in this art to a cosmetic composition in the form of an oil and water emulsion, which contains one or more of the specified polymers of the claims in combination with an organic

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pigment present in an amount of 0.1-95% by weight of the total composition, where that organic pigment is the main color component of the composition is found in applicants' own disclosure of the invention. However, use of that information would constitute impermissible hindsight in the construction of the rejection under 35 U.S.C. §103. In re Fine, 837 F.2d 1071, 1075, 5 U.S.P.Q. 2d 1596, 1600 (Fed. Cir. 1988).

Evidence of Non-obviousness:

In addition to arguing that the three references relied on by the Examiner fail to establish a prima face case of obviousness, applicants would ask that the Examiner to reconsider the data presented in the Declaration of Jean Manelski filed on April 23, 2003 as a part of Paper No. 14.

The Examiner states that the Declaration had been considered but not found persuasive. The Examiner explains that (OA, page 2):

while it compares the compositions in the Examples of McDermott to that of the instantly claimed compositions by replacing iron oxides with water soluble organic pigments and water insoluble organic pigments, placing pigments into various phases of the compositions to correspond with the pigment dispersed phases as claimed, removed waxes, and substituted the ammonium acrylates and added VS-70 or Polysilicone 6 and demonstrates the differences in smudge resistance, color transfer, and film integrity, the instant claims merely recite a "smudge resistant" composition. Since the declaration of Jean Manelski has shown the modified compositions of McDermott as having varying degree of smudging, they must be "smudge resistant" to a certain extent. Smudge resistance is a relative term and without definite parameters as defined in the claims, thus, this term must be given its broadest reasonable interpretation and therefore, applicant has illustrated that the compositions, modified as suggested by the examiner, do have the smudge resistant properties, as claimed.

The Examiner concludes that:

the declaration is not convincing because the instant claims merely require the composition to be "smudge resistant" and the comparative analysis of Jean Manelski has shown the modified compositions of McDermott as having varying smudging properties.

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Initially, applicants would note that there was no intention of suggesting that the compositions of McDermott were not, at least to some degree, resistant to smudging. As McDermott specifically states (column 1, lines 28-29), this is a characteristic which is sought after by those in the cosmetic field and there are many compositions available which might be regarded to be somewhat smudge resistant. What the Declaration does demonstrate is that, surprisingly, the compositions of the present claims, in the form of water and oil emulsions, which include one or more of specific film formers used in combination with organic pigments, where those organic pigments make up the main color component of the composition demonstrate superior smudge resistance when compared to the prior art compositions such as those disclosed by McDermott. That those compositions of McDermott tested may be observed to be somewhat smudge resistant does not obscure or distract from the observed results that the claimed composition gives superior smudge resistance. Smudge resistance is not a claimed feature, but is a characteristic or attribute of the claimed composition and the unexpected level of smudge resistance, observed by Jean Manelski and exemplified in the Declaration, is a function of the specific ingredients present in the claimed composition. The results are summarized at pages 4 and 5 of the Declaration filed April 23, 2003 where the data indicates that all of the tested compositions from the McDermott disclosure demonstrated smudging ranging from "very slight smudging" for Composition T8 and "slight smudging" for Composition C to "pronounced smudging" for Compositions T3, T4, and T6. However, in the same tests, the composition corresponding to the claimed invention demonstrated "no smudging". Clearly this result is superior when compared with the test compositions from McDermott and would not

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have been expected given the observed result that all of McDermott compositions demonstrated at least some level of smudging; and, as such, is evidence of the non-obviousness of the presently claimed cosmetic compositions. Thus, applicants would urge that the evidence of record in the form of the Declaration by Jean Manelski compares the closest related composition of the prior art with the closest related composition of the present claimed invention and should be regarded as sufficient to overcome any initial conclusion that the claimed subject matter is prima facie obvious.

Thus, for the reasons stated, applicants would request that the Examiner reconsider the rejection of claims 1-21 and 23-87, as unpatentable over the combination of Shah (WO 00/47168), McDermott ('336) and further in view of Calello ('275) and withdraw the rejection of these claims under 35 U.S.C. §103(a).

Conclusion:

The Examiner is respectfully requested to reconsider the patentability of all claims pending in the application and the basis of rejections discussed above.

Respectfully Submitted,



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